



AP/1706  
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN THE APPLICATION OF:

DONALD BERNARD BIVENS ET. AL.

CASE NO.: FL1065 US NA

SERIAL NO.: 09/528,964

GROUP ART UNIT: 1751

FILED: MARCH 20, 2002

EXAMINER: HARDEE, JOHN R.

FOR: COMPOSITIONS OF DIFLUOROMETHANE,  
PENTAFLUOROETHANE, 1,1,1,2-TETRAFLUOROETHANE  
AND HYDROCARBONS

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**RESPONSE**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is Applicants' response to the final Office Action that was mailed on January 2, 2004 (Paper No. not indicated) for which a three (3) month shortened statutory period for response was set. Applicants file herewith an amendment under 37 C.F.R. 1.116 and an affidavit under 37 C.F.R. 1.132

Claims 1-7 are pending in the present application. Claims 1-7 have been finally rejected. Claims 1 and claim 7 are amended. Support for the amendments can be found on page 5, lines 23-25. No new matter is added. Entry of the amendment and reconsideration of the rejections is respectfully requested.

The Examiner has maintained the rejection of claims 1, 2, and 4-6 under 35 USC 102 as being unpatentable over JP 9-25480. Applicants demonstrate in the attached Affidavit of Barbara H. Minor, under 37 C.F.R. 1.132, that the compositions of the present invention are novel over the compositions disclosed in JP 9-25480.

JP 9-25480 teaches that non-flammable compositions are produced by using as little as possible hydrocarbon. The least concentration of hydrocarbon exemplified in JP 9-25480 is 5 wt% 2-methylpropane. The data included in the affidavit shows that such composition is flammable.

The Examiner has also maintained the rejection of claims 1-7 under 35 U.S.C. 103 as being unpatentable over WO 96/03473 A1 and JP 9-25480 for the reasons of record. The Examiner stated that Applicants' previous arguments were considered but were not persuasive, stating that the disclosed compositions (in the references) met the limitations of the claims or overlap substantially with the claimed limitations.

The suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not in an applicant's disclosure. In re Vaeck, 20 USPQ.2d 1438 (Fed. Cir. 1991). Applicants demonstrate, via affidavit, that the cited references do not teach or suggest all the claim limitations. JP 9-25480 reference does not disclose compositions that are non-flammable, and azeotropic and comprising the ranges of each component as recited in Applicants claimed invention. In view of Applicant's demonstration of novelty and non-obviousness over the cited references, reconsideration of the rejection is respectfully requested.